REMARKS

This response is submitted in conformity with the revised amendment format wherein provision of 37 C.F.R. §1.121(a), (b), (c) and (d) are waived for certain amendments.

This response provides an Affidavit as previously requested by the Examiner in the first Office Action. Also included is an amendment to the specification.

In the Office Action dated 01/29/2003, the Examiner rejected claims 1-3, and concluded that claims 4-5 contain allowable subject matter.

Turning to the rejection of claims 1-3, the Examiner objected to the amendment filed on 12/02/02 under 35 U.S.C. §132 as introducing new matter. The Examiner declined to enter the amendment of 12/02/02, stating that the added material did not correspond with the International Standard, as originally filed. The Examiner then repeated the rejection originally made in the 8/21/2002 Office Action, wherein claims 1-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lannen et al., in view of an Applicant Admission of Prior Art.

In the 08/21/2002 Office Action, the Examiner objected to the incorporation by reference of certain material. The Examiner requested an Affidavit to overcome the rejection. Subsequently, the amendment filed on 12/02/02, added material which was previously incorporated by reference. A copy of the International Standard from which the added material originated was submitted with an Information Disclosure Statement (IDS). The specification was amended to accurately reflect the title and reference number of the International Standard disclosed in the IDS. Annex B of the International Standard was incorporated as Figure 6. The undersigned attorney represented that the amendatory (added) material corresponded to the material incorporated by reference. No Affidavit was submitted.

In the Office Action of 01/29/2003, the Examiner required cancellation of the new matter added in the 12/02/02 amendment as being new matter not supported by the original disclosure.

Accordingly, an amendment is submitted herein where the 12/02/02 amendment to the title and reference number of the International Standard is effectively cancelled. Therefore, the title and reference number is restored to the condition as originally filed. It is considered that the 01/29/2003 requirement to cancel "new matter" is at least partially addressed.

Furthermore, an Affidavit is submitted herein in accordance with Section 1 of the Office Action of 08/21/2002, and MPEP §608.01(p). It is considered that the Affidavit overcomes rejections based on improper incorporation by reference and any remaining allegations of additions of "new matter," as is explained herein.

In the Office Action of 01/29/2003, the Examiner refused entry of arguments submitted in the amendment entered 12/02/02. The Examiner did so without providing a supporting rationale for the refusal.

Claims 1-3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Lannen et al. (U.S. Patent No.: 5,497,412) in view of the Applicant Admission of Prior Art (AAPA). This rejection is respectfully disagreed with, and is traversed.

The teachings of Lannen et al., as correctly noted by the Examiner, are devoid of disclosure of a hexadecimal check digit calculation procedure. In fact, there is no disclosure of a check digit calculation at all with respect to the message field parameters found at the end of column 18.

The Examiner then states that a "(modulus 16 check digit Luhn algorithm) to convert hexadecimal digits to decimal digits and to calculate check bit is well known in the art". The Examiner's statement is disagreed with. Reference to Annex B of ANSI/ISO/IEC 7812-1-1993 clearly shows that the Luhn formula is based on modulus ten computations, not modulus 16 or hexadecimal computations.

Further, the applicant has not admitted at page 6, lines 4-9, that the conventional Luhn Check Digit computation is one based on modulus 16 arithmetic. Note instead page 5, lines 14-24, where the applicant states that:

> "In accordance with the teachings herein the IMEI is modified so as to have at least a six digit hexadecimal (base 16) SNR representation, and the procedure executed by the unit 35 is modified to utilize the Luhn Algorithm so as to insure backwards compatibility with the existing installed base of mobile stations, having the six digit BCD SNR representation.
>
> More particularly, the check digit calculating procedure is modified so that hexadecimal digits A, B, C, D, E and F are first converted to decimal digits 10, 11, 12, 13, 14 and 15, respectively, and the unit 35 then computes the check bit using the original check bit calculation algorithm (Luhn Algorithm).
>
> Alternatively, the Luhn Algorithm may be modified to use base 16 for all calculations to derive a base 16 check digit."

When page 6, lines 4-9, is read in context, it is clear that the applicant has not admitted that the conventional Luhn Check Digit computation is one based on modulus 16 arithmetic.

It is respectfully submitted that one skilled in the art, when presented by the disclosure of Lannen et al., as it pertains to a prior art ESN expressed in 8 ASCII hex digits (end of column 18), and the prior art modulus 10 Luhn formula (Annex B of ANSI/ISO/IEC 7812-1-1993), would not be lead to the subject matter found in claim 1, i.e., a mobile station:

> "comprising a memory device for storing an International Mobile Equipment Identity (IMEI) code having at least a six digit hexadecimal Serial Number (SNR) representation, wherein said SNR is used with a hexadecimal check digit calculation procedure so as to insure backwards compatibility with an existing installed base of mobile stations having a Binary Coded Decimal (BCD) SNR representation." (emphasis added)

One additional point is submitted herein regarding the rejections of the Examiner, and shows that the position of the Examiner is inherently inconsistent.

In paragraph 4 of the Office Action the Examiner made a statement that is both conclusory and inaccurate. The statement is quoted below and is compared to the specification at page 6, lines 1-9.

> "Lannen et al. do not disclose a hexadecimal check digit calculation procedure. However, such hexadecimal check digit calculation procedure (modulus 16 check digit Luhn Algorithm) to convert hexadecimal digits to decimal digits and to calculate check bit is well known in the art, the examiner takes Official Notice as such, and admitted by the Applicant as prior art (see specification pg. 6/ln. 4-9)."

Referring to page 6, lines 1-9, the specification states:

> "A modulus 16 Luhn Check Digit (CD) is computed over the 14-most significant hexadecimal digits of the IMEISV, that is, on the TAC, FAC and SNR fields, and not on the SVN field of the IMEISV.
>
> The method for computing the Luhn check digit is defined in Annex B of the International Standard "Identification cards-Numbering system and registration procedure for issuer identifiers" (ISO/IEC 7812), incorporated by reference herein in its entirety. In accordance with an aspect of these teachings, the modulus 16 Luhn Check Digit is identical to the conventional procedure, except that the number base is transformed from base 10 to base 16."

The Examiner has confused "these teachings" as providing reference to the immediately prior sentence, which identifies the prior art International Standard. This assumption is incorrect, and provides a logically inconsistent result. As stated above, in Annex B of the International Standard, only a modulus 10 Luhn check digit is disclosed.

However, suppose, for the sake of argument, that "these teachings" do refer to a prior art modulus 16 Luhn check digit. How would a modulus 16 Luhn check digit provide for a distinct procedure that is otherwise "identical to the conventional procedure"? The latter half of this sentence, cited by the examiner, states that distinction lies where "the number base is transformed from base 10 to base 16." Therefore, the same sentence used by the Examiner for the rejection actually substantiates that base 16 is novel over the prior art. Clearly then, the position of the Examiner is inherently inconsistent and fallacious.

The correct analysis provides that the "modulus 16 Luhn Check Digit (CD) is computed" in accordance with the first sentence in the above quote. That is, in the sentence just prior to the reference to the prior art (pg.6, lines 1-3), as well as in accordance with other teachings in the disclosure.

It is considered that the reference to the International Standard in the specification has been restored to the condition as it was in during original filing. It is also considered that the enclosed Affidavit properly establishes correlation between the International Standard as introduced in the specification, and the International Standard identified and submitted in the 12/02/02 IDS. Therefore, the Affidavit dispenses with any remaining allegations wherein Figure 6 may be considered "new matter." That is, any "new matter" referred to by the Examiner is now either cancelled by amendment, or properly supported by the Affidavit.

Accordingly, the entry of previously submitted Figure 6 is respectfully requested. In light of the foregoing reconciliation of the International Standard identified in the specification as originally filed, and the International Standard submitted in the IDS, it should be apparent that Figure 6 properly incorporates Annex B of the International Standard. This incorporation is supported by the Affidavit completed by the inventor, and which properly represents this assertion.

The foregoing clearly establishes that the Applicant has not made an admission that a modulus 16 Luhn Check Digit is prior art. Rejection of claims 1-3 is based on a single portion of the specification, which has been misunderstood. The rejection fails to account for support otherwise found in the written description, and discussed herein. This discussion, portions of which have been previously submitted, has not been reconciled by the Examiner. Should the Examiner remain unpersuaded by the foregoing arguments in light of the Affidavit and amendment submitted herein, it is requested that the Examiner providing a supporting rationale for any continued rejections.

It is respectfully submitted that claim 1 is clearly patentable over the prior art relied on by the Examiner, and that claims 2 and 3 are patentable as well. Claims 1-5 remain pending in this application. It is considered that claims 1-3 are in condition for allowance. It is understood that claims 4-5 have been recognized to contain allowable subject matter.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and in condition for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the Examiner is invited to call Applicant's Attorney at the telephone number indicated below.

Respectfully submitted:

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

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